Docket No. 22HF-165423-296

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Summit Entertainment, LLC Serial No: 77/921,983 Filed: January 28, 2010 Class: 9 Mark: ECLIPSE	Examiner: Priscilla Milton Law Office: 110 **APPLICANT'S REPLY BRIEF**

Applicant Summit Entertainment, LLC ("Applicant") hereby submits this reply brief in support of its appeal of the Examiner's refusal to register Applicant's trademark ECLIPSE in Class 9 under § 2(d) of the Trademark Act on the ground that it is likely to cause confusion, to cause mistake, or to deceive with the following nine marks ("Cited Marks")[1]:

- U.S. Registration No. 799,454 for ECLIPSE for "magnets" in Class 9 owned by Neill Tools Limited ("Neil Tools");
- U.S. Registration No. 1,526,584 for ECLIPSE for "mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers" in Class 9 owned by Fujitsu Ten Limited ("Fujitsu");
- U.S. Registration No. 1,581,195 for

  ECLIPSE

  for "mobile sound equipment and accessories, namely, am-fm tuners, cassette, CD and speakers, amplifiers and equalizers" in Class 9 owned by Fujitsu;
- U.S. Registration No. 2,109,357 for SOLAR ECLIPSE for "sunglasses" in Class 9 owned by Lantis Eyewear Corporation ("LEC");

[1] As noted by the Examiner in the Opposition, U.S. Registration No. 3,544,541 for ECLIPSE DOGGY in Class 28 owned by Mark Der Marderosian has been canceled and no longer a bar to registration of Applicant's mark. (Opposition, p. 2.)

- U.S. Registration No. 3,503,154 for

for "audio and visual equipment, namely, radios, CD players, DVD players, hard disc players, and audio equipment for vehicles, namely, equalizers, amplifiers, speakers, and combination CD/DVD players; navigation apparatus for automobiles in the nature of on-board computers" in Class 9 owned by Fujitsu;

- U.S. Registration No. 3,986,292 for ECLIPSE for "Computer keyboards; Computer game joysticks; Computer mice; Mouse pads; Wireless presenter in the nature of a wireless remote pointer" in Class 9 owned by Mad Catz, Inc. ("Mad Catz");

- U.S. Registration No. 3,986,293 for

for "Computer keyboards; Computer game joysticks; Computer mice; Mouse pads; Wireless presenter in the nature of a wireless remote pointer" in Class 9 owned by Mad Catz;

- U.S. Registration No. 4,150,483 for MIDNIGHT ECLIPSE for "gaming machines, namely, devices which accept a wager" in Class 9 owned by IGT; and

- U.S. Registration No. 4,202,676 for CASH ECLIPSE for "gaming devices, namely, slot machines, with or without video output" in Class 9 owned by Bally Gaming, Inc. ("Bally").

A. Applicant's Limitation of Goods to Those "All Relating to Motion Pictures and Entertainment" Sufficiently Distinguishes its Goods from Registrants' Goods

Applicant has applied to register ECLIPSE for "backpacks adapted for holding computers, camera cases, decorative magnets sold in sheets, decorative wind socks for indicating wind direction and intensity, eyeglasses and eyeglass cases, laptop carrying cases, magnets, mousepads, slot machines, sunglasses and sunglass cases, computer storage devices, namely, flash drives; covers for cell phones, portable and handheld electronic digital devices for playing music, namely, MP3 and MP4 players, laptop computers, personal digital assistants, namely,

PDAs, and gaming devices, namely, gaming machines, ***all relating to motion pictures and entertainment***". (emphasis added.) The Examiner's contention that Registrants' goods are either legally identical to or highly similar to Applicant's goods is incorrect. (Opposition, pp. 6-10.)

The Examiner's evidence of record does not establish that Applicant's goods, as limited to goods "all relating to motion pictures and entertainment," are "identical" or even related to Registrants' goods.

First, the Examiner has not cited any cases where backpacks, magnets and any other goods in Class 9 "all relating to motion pictures and entertainment" have been determined to be similar or related to magnets, computer keyboards, audio and visual equipment and sunglasses. Furthermore, the Examiner has not cited any cases addressing the relatedness to goods "all relating to motion pictures and entertainment" to *any unrestricted identification of goods* in Class 9.

Second, the Examiner has not made of record any web pages or other evidence purportedly reflecting use in commerce where backpacks, magnets and any other goods in Class 9 "all relating to motion pictures and entertainment" are offered under the same brand as watches.

Third, the Examiner has not made of record any third party registrations in which backpacks, magnets, or other goods in Class 9 "all relating to motion pictures and entertainment" are included in the same registration as magnets, computer keyboards, audio and visual equipment, sunglasses and other goods in Class 9 in general. Likewise, the Examiner has not identified any registrations in which *any goods* "all relating to motion pictures and

entertainment" are included in the same registration as magnets, computer keyboards, audio and visual equipment and sunglasses.[2]

The Board has recently held that "associated with" language in the identification of goods or services may be "precatory language, and not binding on consumers" when encountering a particular mark if the language does not alter the nature of the goods or represent that the goods will be marketed in any particular limited way, or through limited trade channels or to any particular class of consumers. *See In re i.am.symbolic, llc*, 2015 TTAB LEXIS 369 at *10 (Oct. 7, 2015).[3] Applicant respectfully submits that the present limitation, "all relating to motion pictures and entertainment" contains a meaningful limitation that would be reflected in the relevant marketplace. Applicant's restriction of its backpacks, magnets and other goods in Class 9 to those "all relating to motion pictures and entertainment" means that Applicant's goods are limited to ones marketed in connection with motion pictures and entertainment. This is an express limitation in the identification of goods. Similarly, Applicant would be precluded from renewing its registration of ECLIPSE for backpacks, magnets and other goods in Class 9 that are not marketed in connection with motion pictures and entertainment. Applicant's marketing of its backpacks, magnets and other goods in Class 9 must have a connection to motion pictures and entertainment in order to assert valid trademark registration rights in its mark. In other words,

[2] The Examiner attached third party registrations to the Denial of the Request for Reconsideration, dated June 15, 2015. The printouts purport to demonstrate "relatedness" between Applicant's goods and Registrants' goods. Applicant filed its Notice of Appeal on March 20, 2015. Applicant requests the Board to strike the third party registrations attached to the Denial of the Request for Reconsideration dated June 15, 2015 as untimely and to give no consideration to them. TBMP § 1207.01 ("The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.")

[3] The Board's decision in In re i.am.symbolic, llc is under appeal to the U.S. Court of Appeals for the Federal Circuit. *See* TTAB Ex Parte Appeal No. 85/044,494, Dkt. No. 42.

Applicant is bound by the language in its identification of goods to advertise and sell goods that do in fact relate to motion pictures and entertainment. This in turn means that the relevant consumers will only encounter goods from Applicant that are *Twilight* Motion Picture branded merchandise. Further, Registrants' marks cannot be associated with the *Twilight* Motion Pictures, lest the Registrants willfully or negligently intend to violate Applicant's rights associated with the *Twilight* Motion Pictures.

This limitation is the identification of goods weighs in favor of a finding that there is no likelihood of confusion between Applicant's mark and the Cited Marks.

B. The Examiner Improperly Overlooks Third Party Use and Registration of ECLIPSE

The Examiner discounted the substantial volume of third party use and registration submitted by Applicant. Notably, the Examiner stated that "these third-party registrations submitted by applicant containing different or unrelated goods and/or services are insufficient to establish that the wording 'ECLIPSE' is weak or diluted." (Opposition, p. 11.)

The Examiner has ignored the number of third party ECLIPSE registrations submitted by Applicant and, instead, has improperly focused on the types of goods and services registered with the registrations. The sheer number of third party ECLIPSE marks, namely 340 registrations, "is powerful on its face" to demonstrate that "a considerable number of third parties use similar marks". *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015) (reversing and remanding Board's finding of a likelihood of confusion between PEACE LOVE AND JUICE and PEACE & LOVE, stating that Board improperly ignored evidence of large volume of third party use and registration). Regardless of the exact type of goods or services offered by these third parties, the fact that 340 ECLIPSE marks exist means that "customers have been educated to distinguish between different marks on the basis of

minute distinctions." *Jack Wolfskin Ausrustung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1375 (Fed. Cir. 2015), citing *Juice Generation*, 794 F.3d at 1338 (internal quotation marks omitted). In *Jack Wolfskin*, the Federal Circuit reversed and remanded the Board's finding of a likelihood of confusion between two different paw print designs for clothing, stating that the Board improperly discounted voluminous evidence of third party paw print use and registrations. The Federal Circuit has underscored that, "[t]he weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection. *Juice Generation*, 794 F.3d at 1338, citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Mainson Fondee En 1772*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). The same result should be found here. Registrants' ECLIPSE marks are only entitled to a narrow scope of protection given the widespread prevalence of ECLIPSE marks in the consumer market, including the very coexistence of the Cited Marks.

C. Conclusion

For the reasons stated above, in its opening brief, and in all of Applicant's other documents and evidence, Applicant respectfully requests that the Board reverse the decision of the Examiner and allow the mark to proceed to publication. Applicant requests oral argument and has separately filed a Request for Oral Argument.

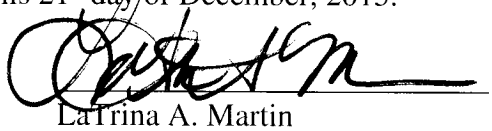
Respectfully submitted,

Dated: December 21, 2015

Jill M. Pietrini
Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this 21st day of December, 2015.



LaTrina A. Martin

SMRH:474182726.1